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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,238	09/03/2004	Jonathan D. Albert	H-427	5237
26245	7590	02/22/2006	EXAMINER	
DAVID J COLE E INK CORPORATION 733 CONCORD AVE CAMBRIDGE, MA 02138-1002			LIANG, REGINA	
			ART UNIT	PAPER NUMBER
			2674	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/711,238	Applicant(s) ALBERT ET AL.	
	Examiner Regina Liang	Art Unit 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-31-05, 3-28-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 8, 9, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 8 and 11, it is unclear as what is meant by “at least one conductive”; does applicant meant at least one conductive electrode or layer or what?

As to claim 9, it is unclear as to “at least one contact pad electrically connected to the at least one”, since it is incomplete.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,825,829. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-15 of this application are broader version of claims 1-15 of U.S. Patent No. 6,825,829.

4. The following is an example for comparing claim 7 of this application and claim 3 of U.S. Patent No. 6,825,829.

Claim 7 of this application	Claim 3 U.S. Patent No. 6,825,829
An electrically active display comprising: an optoelectrically active display medium having first and second surfaces on opposed sides thereof;	An electrically active sticker display comprising: an encapsulated display media having a first surface and a second surface;
an optically transmissive electrode in contact with the first surface of the display medium; and	an electrode is disposed adjacent the second surface of the display media;
an adhesive layer disposed on the second surface of the display medium; wherein the display medium comprises an encapsulated electrophoretic medium.	an adhesive layer disposed on the first surface of the encapsulated display media, the encapsulated display media comprising: an electrophoretic contrast media phase comprising at least one species of electrophoretic particles dispersed in an fluid

	medium; and a binder phase, wherein the electrophoretic contrast media phase is encapsulated in the binder phase such that the electrophoretic particles may move in response to the application of an electrical field to the encapsulated display media.
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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, 10, 12, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tojima et al (US. PAT. NO. 5,368,780 hereinafter Tojima).

As to claim 1, Tojima discloses an electrically active display (col. 1, lines 20-35) comprising: an optoelectrically active display medium (in Fig. 2, herapathites 1 and dispersion medium 5 correspond to optoelectrically active display medium; in Fig. 6, mesh film and suspension correspond to optoelectrically active display medium) having first and second surfaces on opposed sides thereof; an optically transmissive electrode (indium-tin oxide ITO) in contact with the first surface of the display medium; and an adhesive layer disposed on the second surface of the display medium (col. 6, lines 65-66; adhesive layer in Fig. 6).

As to claim 2, Tojima teaches an optically transmissive layer on the opposed side of the electrode from the display medium (glass 2 in Fig. 2; PET film in fig. 6).

As to claims 3, 4, Tojima teaches the electrode comprising indium tin oxide (ITO).

As to claim 6, Tojima teaches the display medium comprises an electrophoretic medium (col. 1, lines 20-32).

As to claim 10, Tojima teaches the process for forming a display comprising providing an electrically active display comprising an optoelectrically active display medium having first and second surfaces on opposed sides therefor (in Fig. 2, herapathites 1 and dispersion medium 5 correspond to optoelectrically active display medium; in Fig. 6, mesh film and suspension correspond to optoelectrically active display medium); an optically transmissive electrode in contact with the first surface of the display medium (electrode indium-tin oxide ITO in contact with the first surface of the display medium), and an adhesive layer disposed on the second surface of the display medium (col. 6, lines 65-66; adhesive layer in Fig. 6); and providing a receiving surface comprising at least one electrode (glass 2 in Fig. 2; PET film in fig. 6); and attaching the electrically active display to the receiving surface by means of the adhesive layer (col. 6, lines 65-66; adhesive layer in Fig. 6).

As to claim 12, Tojima teaches an optically transmissive layer on the opposed side of the electrode from the display medium (glass 2 in Fig. 2; PET film in fig. 6).

As to claim 14, Tojima teaches the display medium comprises an electrophoretic medium (col. 1, lines 20-32).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojima in view of Richley (US. PAT NO. 5,900,858).

Tojima does not disclose the display medium comprises bichromal microspheres. However, Richley teaches a display medium comprising a twisting ball display sheet containing bichromal balls (col. 1, lines 7-8). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the display medium of Tojima to include bichromal microspheres as taught by Richley so as to provide a display medium using different mechanism than Zeta potential to provide a greater dipole moment.

9. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojima in view of Sheridan (US. PAT. NO. 4,126,854).

Tojima discloses the display medium comprises an electrophoretic medium. Tojima does not disclose the display medium comprises an encapsulated electrophoretic medium. However, Sheridan teaches an electrophoretic display medium comprising an encapsulated electrophoretic medium (col. 2, lines 22-25). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the display medium of Tojima to include an

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encapsulated electrophoretic medium as taught by Sheridon so as to provide an display system which has memory capabilities and that is easy to manufacture.

10. Claims 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojima in view of Brody (US. PAT. NO. 6,285,343).

Tojima does not disclose at least one conductive electrode extending from the electrode through the display medium. However, Brody teaches a display device having an extending electrode (interconnecting conductor 30 in Fig. 4a) extending from one side of the display to an opposite side of the display through the display medium for electrically connecting the electrodes on one side of the display with the drive circuit on opposite side of the display. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the display device of Tojima to have an interconnecting conductor as taught by Brody such that electrically connecting the drive circuit adjacent the second surface with the electrode along the first surface.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (571) 272-7693. The examiner can normally be reached on Monday-Friday from 8AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard, can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Regina Liang
Primary Examiner
Art Unit 2674

2/20/06